

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 17, 2004. Claims 1-37 are pending in the application. Claims 1, 2, 5, 10-12, 19, 21, 22, 27, 29, 30, and 35-37 have been amended to further clarify what the inventors believe to be the invention. Claim 14 has been cancelled without prejudice or disclaimer. Applicants submit that no new matter has been added with these amendments. Applicants respectfully request reconsideration and favorable action in this case.

Information Disclosure Statement

Six Information Disclosure Statements (IDS) and accompanying PTO-1449 forms were individually submitted to the Patent office on the following dates: October 23, 2001; March 26, 2002; April 19, 2002; June 20, 2002; August 6, 2002; and November 13, 2002. The Examiner has not provided an indication that the references submitted in the IDSs were considered by the Examiner. For the Examiner's convenience, Applicants have enclosed copies of the previously submitted IDSs and PTO-1449 forms. Additionally, Applicants have included a copy of the date-stamped postcards indicating the submission of the IDSs. Applicants respectfully request that the Examiner consider the cited references, if not already considered, and provide the appropriate indication that they have been considered by initialing next to the references on the PTO-1449 forms.

Claim Objections

The Examiner objects to Claim 35 because of certain informalities. Applicants have amended Claim 35 to address the informalities identified by the Examiner. Accordingly, Applicants respectfully request that the objection to Claim 35 be withdrawn and the claim allowed.

Section 102 Rejections

The Examiner rejects Claims 1-3, 5-9, 19, 20, 27, 28, and 35 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,680,933 issued to Cheesman (hereinafter "*Cheesman*").

Claim 1, as amended, of the present application recites the following:

A method of communicating connectionless and connection oriented signals using at least one common network element, comprising:
receiving connectionless and connection oriented signals from a plurality of source peripheral network elements at an ingress core network element;
determining a signaling type associated with each received signal, the signaling type comprising connectionless signaling or connection oriented signaling;
appending a transport label to each received signal based upon the determination of the signaling type, each transport label comprising:
an indication of the signal's signaling type; and
an interface identifier operable to specify an interface of an egress core network element between the ingress core network element processing the signal and one or more destination peripheral network elements; and
communicating the signals and appended transport labels toward destination peripheral network elements according to signaling procedures associated with each signal's signaling type.

Claim 1 has been amended to incorporate certain features previously recited in dependent Claim 10. As discussed below, Claim 10 was rejected by the Examiner under § 103 as being unpatentable over *Cheesman*. Applicants respectfully submit, however, that *Cheesman* does not disclose, teach, or suggest the combination of features recited in Applicants' independent Claim 1.

For example, Applicants respectfully submit that *Cheesman* does not disclose, teach, or suggest "each transport label comprising . . . an interface identifier operable to specify an interface of an egress core network element between the ingress core network element processing the signal and one or more destination peripheral network elements," as recited in Applicants' Claim 1. *Cheesman* merely discloses a telecommunications switch for switching "protocol data units between communications links connecting the switch into a communications network." (Column 1, lines 46-49). Switch 100 includes an ingress process 112, connected to a switching fabric 103, which is connected to an egress processor 114. (Column 8, lines 20-22). Although *Cheesman* discloses that ingress processor 112 undertakes a look up in order to determine a destination port, *Cheesman* explicitly states that

the destination port is “within the switch 100.” (Column 8, lines 33-37). More specifically, “[t]he destination port would be one of the access interfaces 102a, 102b, 102c or the network interfaces 104a, 104b,” which are also within switch 100. (Column 8, lines 38-40; Figure 4). Thus, the switching tag merely includes destination port information about internal interfaces within switch 100. Accordingly, Applicants respectfully submit that the combinations of references, as relied upon by the Examiner, do not disclose, teach, or suggest “each transport label comprising . . . an interface identifier operable to specify *an interface of an egress core network element between the ingress core network element processing the signal and one or more destination peripheral network elements*,” as recited in Applicants’ Claim 1.

For at least these reasons, Applicants request reconsideration and allowance of Claims 1.

Independent Claims 19 and 27 have been amended to incorporate certain features previously recited in dependent Claims 21 and 30, respectively. Certain of the features incorporated into Claims 19 and 27 are similar, though not identical, to those discussed above with regard to Claim 1. For example, Claim 19 recites “the transport label including an interface identifier operable to specify an interface of an egress core network element between the ingress core network element processing the signal and one or more destination peripheral network elements.” Claim 27 recites “the transport label including an interface identifier operable to specify an interface of an egress core network element between the ingress core network element processing the signal and one or more destination peripheral network elements.” As discussed above with regard to Claim 1, the switching tag disclosed in *Cheesman* merely includes destination port information about internal interfaces within switch 100. Accordingly, for reasons similar to those discussed above with regard to Claim 1, Applicants respectfully submit that *Cheesman* does not disclose, teach, or suggest each and every element recited in Applicants’ independent Claims 19 and 27.

Claims 2-3 and 5-9 depend directly or indirectly upon Claim 1, which Applicants have shown above to be allowable. Claim 20 depends directly or indirectly upon Claim 19, which Applicants have also shown above to be allowable. Claims 28 and 35 depend directly

or indirectly upon Claim 27, which Applicants have also shown above to be allowable. Thus, for the same reasons that independent Claims 1, 19, and 27 are allowable, these dependent claims are also allowable.

Additionally, dependent Claims 2-3, 5-9, 20, 28 and 35 recite limitations that are not disclosed, taught, or suggested by the prior art. For example, Claim 2 recites that “the signaling type associated with a particular signal further comprises a combination of connectionless and connection oriented signaling.” *Cheesman* discloses that the protocol data unit is parsed to determine the service associated with the protocol data unit from the switching tag. (Column 10, lines 11-16). *Cheesman* further provides that the “service will be one of several predetermined services which the switch 100 has been configured to support” and may be “one of ATM, IP, or IPVPN.” (Column 10, lines 16-21). Because *Cheesman* explicitly states that the service will be *one* of several types of services, *Cheesman* does not disclose, teach, or suggest “the signaling type associated with a particular signal further comprises a combination of connectionless and connection oriented signaling,” as recited in dependent Claim 2.

As another example, Claim 35 recites, “a peripheral interface operable to receive the network signal from the first peripheral network element, and to communicate network signals received from the core network element to the second peripheral network element.” As discussed above with regard to Claim 1, the switching tag disclosed in *Cheesman* merely includes destination port information about internal interfaces within switch 100. Accordingly, *Cheesman* does not disclose, teach, or suggest a peripheral interface operable “to receive the network signal from the first peripheral network element” and “to communicate network signals received from the core network element to the second peripheral network element.”

Thus, for the reasons discussed immediately above and for reasons similar to those discussed with regard to Claim 1, Applicants respectfully submit that the dependent Claims 2-3, 5-9, 20, 28, and 35 are also allowable.

Section 103 Rejections

The Examiner rejects Claims 4, 10-12, 14-18, 21-26, 29-34, 36, and 37 under 35 U.S.C. § 103(a) as being unpatentable over various combinations of *Cheesman*, U.S. Patent Number 6,628,649 issued to Raj (hereinafter "*Raj*"), and U.S. Patent Number 6,526,056 issued to Rekhter et al. ("*Rekhter*"). For the following reasons, Applicants respectfully traverse the rejections of Claims 4, 10-12, 14-18, 21-26, 29-34, 36, and 37.

The Cited References Do Not Disclose Each and Every Element of the Claims

First, to render claims obvious under 35 U.S.C. § 103, "the prior art references must teach or suggest all the claim limitations." *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 706.02(j). Applicants respectfully submit that the proposed combinations of references do not disclose, teach, or suggest each and every element recited in Applicants' claims.

For example, Independent Claim 11 has been amended to incorporate features previously recited in dependent Claim 14, which has been cancelled without prejudice or disclaimer. Certain of the features incorporated into Claim 11 are similar, though not identical, to those discussed above with regard to Claim 1. For example, Claim 11 recites "the bottom sub-transport label includes an interface identifier operable to specify an interface of an egress core network element between the ingress core network element processing the signal and the destination peripheral network element." The Examiner specifically relies on *Cheesman* for disclosure of the interface identifier recited in Applicants' claims. As discussed above with regard to Claim 1, however, the switching tag disclosed in *Cheesman* merely includes destination port information about internal interfaces within switch 100. Accordingly, for reasons similar to those discussed above with regard to Claim 1, Applicants respectfully submit that *Cheesman* does not disclose, teach, or suggest each and every element recited in Applicants' independent Claim 11.

Dependent Claims 12, 14-18, and 36 depend directly or indirectly upon independent Claim 11, which Applicants have shown above to be allowable. Claims 21-26 and 37 depend directly or indirectly upon independent Claim 19, which Applicants have also shown above

to be allowable. Claims 29-34 depend upon independent Claim 27, which Applicants have also shown above to be allowable. Since Claims 12, 14-18, 21-26, 29-34, 36, and 37 incorporate the limitations of their respective independent claims, Applicants have not provided detailed arguments with respect to Claims 12, 14-18, 21-26, 29-34, 36, and 37. Applicants remain ready to do so, however, if it becomes appropriate. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 12, 14-18, 21-26, 29-34, 36, and 37.

One of Ordinary Skill in the Art Would not have been Motivated to Make the Proposed *Cheesman-Rekter* Combination

Moreover, assuming for purposes or argument that the proposed combination discloses the limitations of Applicants' claims, which Applicants dispute, it would not have been obvious to one skilled in the art to make the combination. The mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). The showing must be clear and particular. *See, e.g., C.R. Bard v. M3 Sys., Inc.*, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998). The Examiner has not provided adequate evidence of the required motivation or suggestion to make the proposed combination. The Examiner merely speculates "it would have been obvious" to modify *Cheesman* "to implement [the] tag stack of *Rekter* in the system of *Cheesman*." (Office Action, page 11). However, the Examiner's speculation is not adequate evidence of the requisite suggestion or motivation necessary to make the proposed *Cheesman-Rekter* combination. Rather, the Examiner's conclusory "it would have been obvious" statement simply relies upon a hindsight reconstruction of Applicants' claimed invention.

It is improper for an Examiner to use hindsight having read the Applicants' disclosure to arrive at an obviousness rejection. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Stated differently, it is improper to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Because the Examiner has merely used Applicants' claims as an instruction

manual to piece together the switch disclosed in *Cheesman* with the stacked tag disclosed in *Rekhter*, Applicants respectfully submit that the proposed *Cheesman-Rekhter* combination is improper and should not be used here to reject Applicants' claims.

Furthermore, Applicants posit that there is no basis in the prior art to combine *Cheesman* and *Rekhter*. To defeat a patent under 35 U.S.C. §103, the claimed combination must be obvious. *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 223 U.S.P.Q. 603 (Fed. Cir. 1984). It is essential to view the invention as a whole, taking each element into account as well as the advantages, properties, utilities, and results of the invention. *In re Chupp*, 816 F.2d 643, 2 U.S.P.Q.2d 1437 (Fed. Cir. 1987). Furthermore, even where an invention is, as a whole, fully disclosed by a combination of prior art elements (which Applicants dispute here), such elements cannot be combined to defeat a patent as obvious unless the art teaches or suggests the desirability of making the claim combination. *ASC Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 U.S.P.Q. 929 (Fed. Cir. 1984). Without such independent suggestion, the art is to be considered as merely inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Agmen Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 18 U.S.P.Q.2d 1016 (Fed. Cir. 1991). Thus, the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, U.S.P.Q.2d 1780 (Fed. Cir. 1992). Additionally, if a "proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." (M.P.E.P. § 2143.01).

Applicants submit that one of ordinary skill in the art at the time of Applicants' invention would not have been motivated to combine the switch of *Cheesman* with the stacked tagging system of *Rekhter* to result in a stack of sub-transport labels that include "a node identification useful in determining a next hop *for a connectionless signal or* a path identification useful in determining a virtual circuit *for a connection oriented signal*," as recited in Applicants' independent Claim 11. The objective of *Cheesman* is to provide a

switch supporting multiple service types. (Abstract). To this end, *Cheesman* discloses that “a protocol data unit could belong to an ATM bearer virtual channel *or* an IP/MPLS label switched path.” (Column 8, lines 30-32). Thus, *Cheesman* discloses a switch having the capability of providing class-based traffic management and flow-based traffic management on a per service basis for both connectionless and connection oriented traffic. (Column 3, lines 2-7). The objective of *Rekhter*, on the other hand, is to provide a system for tagging IP network traffic only. (Column 7, lines 56-62). In fact, *Rekhter* does not provide any disclosure at all about tagging connection oriented traffic, and neither *Cheesman* nor *Rekhter* provide any suggestion or motivation for applying a stacked tagging system to connection-oriented traffic.

For at least these reasons, Applicants respectfully submit that the proposed *Cheesman-Rekhter* combination is improper. Accordingly, Applicants’ respectfully request that the rejection of Applicants’ claims over the proposed *Cheesman-Rekhter* combination be withdrawn and the claims allowed.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants


Brian W. Oaks
Reg. No. 44,981

Date: 6/17/04

Correspondence Address:

Baker Botts L.L.P.
2001 Ross Avenue, Suite 600
Dallas, Texas 75201-2980
Tel. (214) 953-6986

Customer Number: **05073**